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10/611,424

07/02/2003

Yolanta Beresnevichiene

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EXAMINER

WRIGHT, JAMES B

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/611,424	Applicant(s) BERESNEVICHIE, YOLANTA	
	Examiner J. Bradley Wright	Art Unit 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/19/2003</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). Further, receipt is acknowledged of the certified copy of the priority document submitted on November 7, 2003.

Claim Rejections - 35 USC § 112, First Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.
3. In particular, the claims recite "a result" based on a previous determination (see e.g. claim 1, lines 7-8). However, the specification does not describe the claimed "result" in such a way as to enable one skilled in the art to ascertain the scope or definition of the limitation beyond that it is based on the previous determination, and therefore, fails to enable one skilled in the art to which it pertains to make and/or use the claimed invention.

Claim Rejections - 35 USC § 112, Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention

4. Claims 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. **Regarding claim 19**, the claim recites the limitation “a result” on line 7. However, claim 61, upon which claim 19 depends, also recites “a result” on line 7. It is unclear as to whether the “result” recited in claim 19 is a separate and distinct result, or whether the two recited results in claims 16 and 19 are simply duplicative.

Similarly, it is unclear as to whether the steps recited in claim 19 are additional steps to be performed or whether they are directed to a modification of the similar steps recited in the base claim.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 16-23 and 26-31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In particular, the inventions of

claims 16-23 and 26-31 fail to accomplish a practical application. That is, they do not produce a “useful, concrete and tangible result.”

7. According to MPEP § 2106, a claimed invention is directed to a practical application of a 35 U.S.C. 101 judicial exception when it:

- (A) “transforms” an article or physical object to a different state or thing; or
- (B) otherwise produces a useful, concrete and tangible result, based on the factors discussed below

In making this determination, the focus is not on whether the steps taken to achieve a particular result are useful, tangible, and concrete, but rather on whether the final result achieved by the claimed invention is “useful, tangible, and concrete.” The determination of whether a claim provides a practical application of a 35 U.S.C. 101 judicial exception that produces a useful, tangible, and concrete result includes the following factors:

a) "USEFUL RESULT"

For an invention to be “useful” it must satisfy the utility requirement of section 101. The USPTO's official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible. MPEP § 2107. In addition, when there is reason to believe that the claim is not for a practical application that produces a useful result, the claim should be rejected, thus requiring the applicant to distinguish the claim from the three 35 U.S.C. 101 judicial exceptions to patentable subject matter by specifically reciting in the claim the practical application. In

such cases, statements in the specification describing a practical application may not be sufficient to satisfy the requirements for section 101 with respect to the claimed invention. Likewise, a claim that can be read so broadly as to include statutory and nonstatutory subject matter must be amended to limit the claim to a practical application. In other words, if the specification discloses a practical application of a section 101 judicial exception, but the claim is broader than the disclosure such that it does not require a practical application, then the claim must be rejected.

b) "TANGIBLE RESULT"

The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a 35 U.S.C. 101 judicial exception, in that the process claim must set forth a practical application of that judicial exception to produce a real-world result. In other words, the opposite meaning of "tangible" is "abstract."

c) "CONCRETE RESULT"

Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. In other words, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. The opposite of "concrete" is unrepeatable or unpredictable.

8. The invention of the rejected claims involves deriving “a result” based on a previous determination. However, the claimed “result” is undefined in the claims and specification, and there is no practical application claimed. As such, the claim is directed toward determining whether a process step complies with a rule in order to derive the undefined “result”, but provides no practical application of such a determination or result. Since such a practical application cannot be found, the claims do not produce a useful, concrete and tangible result, and therefore, the claims are nonstatutory.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-5, 9, 10, 16-20, 24, 25 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Gibson, et al. (US Patent No. 6,006,193).

10. **Regarding claims 1, 16 and 31**, Gibson discloses a method, apparatus and storage device for analyzing an electronic representation of a business process (see Figures 1 and 6, and Abstract), including:

- accessing a rules database including at least one process rule for at least one process step (column 1, lines 11-14 and 24-34; column 2, lines 25-26 and 56-63; and column 9, line 66 – column 7, line 41); and

- determining whether a process step complies with at least one process rule of the rules database, and deriving a result based on the determination of whether the at least one process step complies with the at least one process rule (column 1, lines 44-53; column 4, lines 36-67; and column 7, line 55 - column 8, line 37).

11. **Regarding claims 2 and 17**, Gibson further discloses that at least one process step is associated with at least one predetermined process rule (column 1, lines 24-26).

12. **Regarding claims 3 and 18**, Gibson further discloses that the rules database comprises data of a process step that will satisfy a predetermined process rule (column 1, lines 11-14, 24-34, and column 7, line 55- column 8, line 37).

13. **Regarding claims 4 and 19**, Gibson further discloses that the rules database comprises a plurality of process rules and determining whether a process step complies with all applicable process rules (column 1, lines 11-14, 24-34 and 44-53; column 2, lines 25-26 and 56-63; column 4, lines 36-67; and column 7, line 55 - column 8, line 37).

14. **Regarding claims 5 and 20**, Gibson further discloses that the rules database comprises a plurality of process rules for a plurality of process steps (column 1, lines 11-14 and 24-34).

15. **Regarding claims 6 and 21**, Gibson further discloses reporting the result of the process analyzer (column 9, line 66 - column 7, line 23).

16. **Regarding claims 9 and 24**, Gibson further discloses modifying a process step of the electronic representation of the business process to comply with the rules database (column 9, lines 1-65).

17. **Regarding claims 10 and 25**, Gibson further discloses that the rules database comprises a predetermined process modification for compliance with a given rule (column 9, lines 1-65).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 7-8 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gibson in view of Official Notice.

19. **Regarding claims 7-8 and 22-23**, Gibson teaches the limitations of claims 6 and 21, respectively, as discussed above. While Gibson teaches that output data may be applied to output devices, Gibson does not explicitly disclose the particular output devices. The Examiner takes Official Notice that it was old and well-known in the art at the time the invention was made that output data may output to a user in a variety of known manners, such as being printed on a printer or being saved to a memory device as a digital file, depending on the particular requirements of the user. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to output or report data to a user of the system of Gibson in a conventional manner, such as printing on a printer or saving as a digital file to a memory device, in order to comport with the needs and wants of the user, as was old and well-known.

20. Claims 11-13 and 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gibson in view of Klemba, et al. (European Patent Application EP 0 736 827 A2) (cited by Applicant).

21. **Regarding claims 11-13 and 26-28**, Gibson teaches the limitations of claims 1 and 16, respectively, as discussed above. Gibson further discloses the use of rules specifying a protocol for executing work items, such as who may work on a work item, as applied to the approval of purchase orders (column 1, lines 24-34 and column 7, line 55 - column 8, line 37). However, Gibson does not explicitly disclose that the rules database includes a process accountability rule. The Examiner notes, as a preliminary

matter, that the present specification identifies a requirement for digital signatures as an accountability rule.

Klemba, in an analogous art, teaches a system and method for governing the administration of security policies in the context of electronic workflow (column 1, line 31 – column 2, line 6), wherein checkpoints are placed within the workflow that require certain criteria to implement security policies to be met before further processing is allowed (column 3, lines 10-41). For example, Klemba teaches that when an employee reaches a certain point in the workflow, the checkpoint may require authorization from a specific supervisor in the form of a password or digital signature, for the purpose of creating and maintaining a secure audit trail of all authorizations and employees in order to prevent fraud and collusion (column 8, line 52 – column 10, line 14). Klemba further teaches that the checkpoint may further collect information regarding time at which the task was checkpointed for approval and when it was approved (column 9, lines 1-16).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the workflow of Gibson to include checkpoints placed within the workflow that require certain criteria to implement security policies to be met, such as the entry of digital signature (e.g. an accountability rule), and to record the various times at which tasks were submitted and approved, in order to build and maintain a secure audit trail in order to prevent fraud and collusion, as taught by Klemba.

22. Claims 14, 15, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gibson in view of Klemba, as applied above, and further in view of Official Notice.

23. **Regarding claims 14, 15, 29 and 30**, Gibson does not explicitly disclose non-repudiation rules. However, Klemba further teaches that the security administration policy is implemented to supervise non-repudiation (column 7, lines 9-42) to further ensure a secure audit trail. The Examiner takes Official Notice it was old and well-known in the art at the time of invention that in the field of digital signatures, non-repudiation is generally accomplished by verifying the digital signature using known techniques, such as verification using hash functions, public keys, and/or trusted third party (TTP) systems, for the purpose of ensuring the legitimacy of the signature and identity of the signatory. In this manner, the submitter of the digital signature cannot repudiate or challenge the action at a later time. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made verify a submitted digital signature submitted to the system of Gibson, in order to ensure the legitimacy of the signature and identity of the signatory, as was old and well-known.

Conclusion

24. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Turley, et al. (US Patent No. 5,940,804) discloses a computer executable workflow resource management system.
- Piskiel, et al. (US Patent No. 5,893,911) discloses a method for defining and applying rules for message distribution for transaction processing in a distributed application.
- Stolfo, et al. (US Patent No. 5,363,473) discloses an incremental update process and apparatus for an inference system.
- Reifman, et al. (US Patent No. 5,265,035) discloses a system diagnostics using qualitative analysis and component functional classification.
- Chang (US Patent No. 5,263,126) discloses an automatic expert system.
- Skeirik (US Patent No. 5,006,992) discloses a process control system with reconfigurable expert rules and control modules.
- Degenaro, et al. (US Patent No. 6,341,369) discloses a method and data processing system for specifying and applying rules to classification-based decision points in an application system.
- Blando (US Patent No. 6,185,583) discloses a parallel rule-based processing of forms.
- Schutzman, et al. (US Patent No. 5,627,764) discloses an automatic electronic messaging system with feedback and work flow administration.
- Moore, et al. (US Patent No. 5,446,885) discloses an event driven management information system with rule-based applications structure stored in a relational database.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bradley Wright whose telephone number is (571)272-5872. The examiner can normally be reached on M - F 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/jbw/

/James P Trammell/
Supervisory Patent Examiner, Art Unit 3694

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